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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,272	10/31/2003	Stefek Malkowski Zaba	200308879-2	7911

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FORT COLLINS, CO 80527-2400

EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,272

Applicant(s)

ZABA ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta (EP 179 811), as cited by the Applicant.

Arrieta teaches a security document with one or more memory circuits to be read wirelessly attached to or incorporated within the printed document wherein the memory circuit is physically isolated so as to inhibit physical tampering or to indicate when physical tampering has occurred (abstract, FIG. 1 and 2, and paragraph [0043]+). Though Arrieta is silent to a printed document, Arrieta teaches the security document includes documents such as banknotes, checks, stocks, bonds, passports, identity cards, etc. (paragraph [0043]). It is well known and conventional in the art that such documents are printed for identification purposes. Though Arrieta is silent to the memory circuit being protected from access by an unauthorized reader, the examiner notes that it is well known and conventional in the art methods of mutual verification between a reader and a security document are well known in the art and usually rely on cryptographic keys, derivatives thereof, public keys, digital signatures, etc. to verify the reader and the document to authorize/validate an exchange of data between the document and reader (see Teicher et al. US 6,257,486, for example). Further, Arrieta (EP 1 179 810), as cited by the Applicant, also teaches protecting of the information from the public (paragraph 006)+). Therefore, it is well known and conventional in the art to protect access by an unauthorized reader, as a means to provide security.

Re claim 2, it is well known and conventional in the art that passive security documents are powered inductively, to reduce document size/cost, and/or increase its life since a power source is not required. Further, Arrieta teaches mutual inductance of the antennas (paragraph [0028] +).

Re claim 3, Arrieta teaches wireless transmission at radio frequency (paragraph [0024] +), as is well known and conventional in the art.

Re claim 5, Arrieta teaches that the antenna is used for detection or resistance of physical tampering, since it is incorporated into the hologram, as discussed above.

Re claim 6, as Arrieta teaches the security document can include an identity card (see above) it is well known and conventional that the document identifies an authorized bearer of the document, as is well known and conventional in the art.

Re claim 7, Arrieta teaches the document can include an identity card, passports, etc. Accordingly, it is well known and conventional in the art for documents to be used to permit access to assets of an identified authorized bearer of the document (see Sehr US 2002/0100803, for example).

Re claims 8 and 12, the limitations have been discussed above. It is understood that documents have first information determined for printing, and second information for storing/being written into the memory circuit, as is well known and conventional in the art.

Re claims 9, 11, and 12 the limitations have been discussed above. Further, it is well known and conventional in the art that printed document information is used with stored information in a security document/card to assess the security document, such as the case with the using/comparing of the printed image/information/characteristics of the bearer of the

document with those stored in the document memory/circuit/chip. Such means are well known and conventional for providing secure identification/validation means. Further, Tsuji et al. (EP 1 139 302), as cited by the Applicant, teaches that stored information is used with/compared with printed information to verify a document (col 3, lines 39+). Therefore, such verification means are well known and conventional in the art for providing security.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta, as applied to claim 1 above, further in view of Minkus (US 5,090,736).

The teachings of Arrieta have been discussed above.

Arrieta teaches that the circuit employs tamper evident means (see claim 1), as the emitter device is integrated into the hologram, and attempted tampering of the emitter device (the more significant part of the document) is therefore apparent. Arrieta is silent to the specific use of tamper evident strips, but the examiner notes that the teachings of Arrieta teach tamper indicating without the use of tamper evident strips, as tampering is evident through destruction/modification of the hologram. Accordingly, the hologram is broadly interpreted as a tamper evident strip, itself.

Regardless, Minkus teaches tamper evident strips 25 that are used to indicate tampering with the document.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Arrieta with those of Minkus

One would have been motivated to do this to provide for a visual means of detecting tampering, which is well known and conventional.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sehr (US 2002/0100803), Reymond (US 5,898,370), and Teicher et al. (US 6,257,486).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

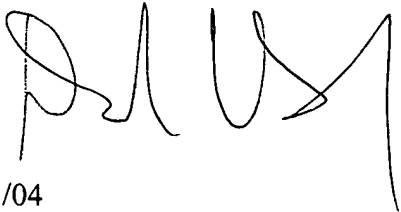

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/697,272
Art Unit: 2876

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D. Walsh

DW
3/15/04

A handwritten signature in black ink, appearing to be 'DW' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'Karl D. Frech'.

**KARL D. FRECH
PRIMARY EXAMINER**